

**R E M A R K S**

Careful review and examination of the subject application are noted and appreciated.

**SUPPORT FOR CLAIM AMENDMENTS**

Support for the amendments to the claims can be found in the drawings as originally filed, for example, on FIGS. 1a and 1b and in the specification as originally filed, for example, on page 12, line 5 through page 13, line 6. Claim 20 has been put in the form of a computer program product claim (see *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)) as suggested by the Examiner (see page 4, last 11 lines and page 5, lines 1-2 of the Office Action). As such, no new matter and no new issues have been introduced.

**IN THE DRAWINGS**

Replacement drawings for FIGS. 2 and 3 are submitted herewith. Formal drawings will be submitted upon receipt of a notice of allowance. As such, the objection to FIGS. 2 and 3 should be withdrawn.

**IN THE SPECIFICATION**

The title of the invention has been amended as suggested by the Examiner. As such, no new matter has been added.

**CLAIM OBJECTIONS**

The objections to claims 6, 14, 15 and 18 have been obviated by appropriate amendment and should be withdrawn.

The objections to claims 1, 4, 15-17, 19 and 20 are respectfully traversed and should be withdrawn. Specifically, the presently recited claim language of "said family of devices ... comprises" (see line 4 of claims 1 and 19, line 2 of claim 4, line 2 of claim 15, line 2 of claim 16, line 2 of claim 17, and lines 11-12 of claim 20) is grammatically correct as evidenced by the section entitled "Agreement: Nouns and Verbs" from The Practical Stylist, 4<sup>th</sup> Ed., by Sheridan Baker, 1977, pp. 125-126 (attached as Exhibit A; hereinafter Baker). In particular, family is a single unit and, therefore, takes a singular verb regardless of a plural construction (e.g., the phrase "of devices") falling between the singular subject and its verb (see page 126 of Baker). Therefore, the suggested changes do not appear to be grammatically proper. As such, the objection to claims 1, 4, 15-17, 19 and 20 is respectfully traversed and should be withdrawn.

**CLAIM REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

The rejection of claim 20 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement is respectfully traversed and should be withdrawn.

In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention (MPEP §2164.04,

citing *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). It is incumbent upon the Patent Office, whenever a rejection on an enablement basis is made, to explain why the Patent Office doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement (MPEP §2164.04 quoting *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971)).

The specification states:

The function performed by the flow charts of FIGS. 1a and 1b may be implemented using a conventional general purpose digital computer programmed according to the teachings of the present specification, as will be apparent to those skilled in the relevant art(s). Appropriate software coding can readily be prepared by skilled programmers based on the teachings of the present disclosure, as will also be apparent to those skilled in the relevant art(s) (See page 12, lines 5-12 of the specification).

A person of ordinary skill in the art would recognize that the elements of claim 20 correspond to the functions recited in the flow charts of FIGS. 1a and 1b. Furthermore, a person of ordinary skill in the art would recognize that the term "device", as recited in claim 20, can be used to refer to a computer. Specifically, the definition of "computer" found in the Microsoft Computer Dictionary, Fifth Edition, (attached as Exhibit B) states that a computer is "[a]ny **device** capable of processing information to produce a desired result" (emphasis added).

The Office Action does not explain why the Patent Office doubts the truth or accuracy of the statements in the specification (see page 4, paragraph no. 6 of the Office Action). The Office Action does not back up the assertions made with acceptable evidence or reasoning which is inconsistent with the contested statement (see page 4, paragraph no. 6 of the Office Action). Therefore, the Office Action fails to meet the Patent Office's burden to establish a reasonable basis to question the enablement provided for the claimed invention (MPEP §2164.04). As such, the rejection of claim 20 as failing to comply with the enablement requirement is respectfully traversed and should be withdrawn.

Furthermore, the Examiner's statement that "Applicant's specification does not enable a device configured to generate a superset pinout" is contradicted by the Office Action dated January 5, 2005, in which the Examiner stated:

Applicant's specification ... enables a configured device. For examination purposes, the claim is treated as reciting "a device configured to generate a superset pinout. ..." (see page 4, lines 4-7 of the Office Action dated January 5, 2005).

Furthermore, the Examiner presents no evidence that one of ordinary skill in the art would be unable to make and/or use the present invention based upon the specification without undue experimentation. As such, the presumption that the presently claimed invention is enabled is intact and the rejection should be withdrawn.

However, in light of the Examiner's statement that a computer program product claim (see *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)) would provide additional coverage, claim 20 has been amended based upon the Examiner's suggestions (see page 4, last 11 lines and page 5, lines 1-2 of the Office Action). The Office Action admits that the specification discloses a computer program product having instructions to execute the method of Applicant's invention (see page 4, last 11 lines of the Office Action). As such, the presently claimed invention is fully patentable under 35 U.S.C. §112, first paragraph, and the rejection should be withdrawn.

**CLAIM REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

The rejection of claim 20 under 35 U.S.C. §112, second paragraph, as failing to set forth the subject matter which Applicant regards as his invention is respectfully traversed and should be withdrawn.

Specifically, the specification states:

The function performed by the flow charts of FIGS. 1a and 1b may be implemented using a conventional general purpose digital computer programmed according to the teachings of the present specification, as will be apparent to those skilled in the relevant art(s). Appropriate software coding can readily be prepared by skilled programmers based on the teachings of the present disclosure, as will also be apparent to those skilled in the relevant art(s) (See page 12, lines 5-12 of the specification).

A person of ordinary skill in the art would recognize that the elements of claim 20 correspond to the functions recited in the flow charts of FIGS. 1a and 1b. Furthermore, a person of ordinary skill in the art would recognize that the term "device", as recited in claim 20, can be used to refer to a computer. Specifically, the definition of "computer" found in the Microsoft Computer Dictionary, Fifth Edition, (attached as Exhibit B) evidences that a person of ordinary skill in the art would understand a computer is "[a]ny **device** capable of processing information to produce a desired result" (see definition of computer, Microsoft Computer Dictionary, Fifth Edition, page 118, emphasis added).

Furthermore, the Examiner's reliance on the specification to support the rejection under 35 U.S.C. §112, second paragraph, is not proper. In particular, "agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section" (MPEP §2172(II)). As such, the rejection of claim 20 under 35 U.S.C. §112, second paragraph, is not proper and should be withdrawn.

However, in light of the Examiner's statement that a computer program product claim (see *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)) would provide additional coverage, claim 20 has been amended based upon the Examiner's suggestions (see page 4, last 11 lines and page 5, lines 1-2 of the Office Action). The Office Action admits that the specification discloses a computer program product having instructions to execute the method of

Applicant's invention (see page 4, last 11 lines of the Office Action). As such, the presently claimed invention is fully patentable under 35 U.S.C. §112, second paragraph, and the rejection should be withdrawn.

**SHOWING UNDER 37 CFR 1.116**

An amendment may be made cancelling claims or complying with any requirement of form expressly set forth in a previous Office Action after a final rejection (37 CFR §1.116). The amendment of claims 6, 14, 15, and 18 complies with the requirements in section 4 on page 3 of the final Office Action. The amendment of claim 20 follows the Examiner's suggestion for overcoming the rejection under 35 U.S.C. 112, second paragraph in section 8 on page 4 of the final Office Action. Therefore, since the amendments were made complying with a requirement of form set forth in the previous Office Action, the amendments to the claims comply with 37 CFR §1.116(b)(1) and should be entered.

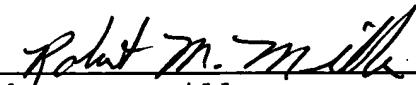
Accordingly, the present application is in condition for allowance (see page 5, lines 4-6 of the Office Action). Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative, Robert Miller, should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office  
Account No. 50-0541.

Respectfully submitted,

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Dated: August 17, 2005

Docket No.: 0325.00503

EXHIBIT A  
PAGE 1 of 4

# THE PRACTICAL STYLIST

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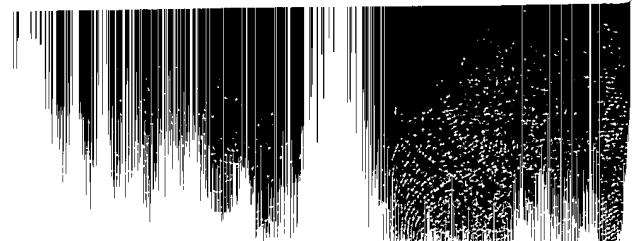


EXHIBIT A  
PAGE 2 of 4

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Published simultaneously in Canada by  
Fitzhenry & Whiteside, Ltd., Toronto.

Library of Congress Cataloging in Publication Data

Baker, Sheridan Warner  
The practical stylist.

1. English language—Rhetoric. I. Title.  
PE1408.B283 1977 808'.042 76-26601  
ISBN 0-690-00873-2

Thomas Y. Crowell Company  
666 Fifth Avenue  
New York, New York 10019

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EXHIBIT A  
PAGE 3 of 4

AGREEMENT: NOUNS AND VERBS 125

PAST PARTICIPLES: The nurses treated the *wounded* soldier. [adjective]

The nurses treated the *wounded*. [noun]

GERUND PHRASE: *His going* ended the friendship. [noun, subject of sentence]

INFINITIVES: *To err* is human; *to forgive*, divine. [nouns, subjects of sentence]

I saw him [to] go. [phrase serving as noun, object of *saw*; him subject of *to go*]

Ford is the man *to watch*. [adjective]

Coiled, the snake waited *to strike*. [adverb]

CONJUNCTIONS. Conjunctions join words, phrases, and clauses.  
*Coordinating conjunctions—*and, but, or, yet—join equals:

Mary and I won easily.

Near the shore but far from home, the bottle floated.

He was talented, yet he failed.

*Subordinating conjunctions* attach clauses to the basic subject-and-verb:

Since it was late, they left.

He worked hard because he needed an A.

They stopped after they reached the spring.

INTERJECTIONS. Interjections interrupt the usual flow of the sentence to emphasize feelings:

But, oh, the difference to me.

Mr. Dowd, alas, has ignored the evidence.

The consumer will suddenly discover that, ouch, his dollar is cut in half.

## AGREEMENT: NOUNS AND VERBS

Make your verb and its subject agree.

Match singulars with singulars, plurals with plurals. First find the verb, since that names the action—*sways* in the following sentence: "The poplar tree *sways* in the wind, dropping yellow leaves on the lawn." Then ask *who* or *what* *sways*, and you have your simple subject: *tree*, a singular noun. Then make sure that your singular subject matches its singular verb. (A reminder: contrary to nouns, the majority of singular verbs end in *s*—*actors perform*; *the actor performs*.) You will have little trouble except when subject and verb

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126 A. A WRITER'S GRAMMAR

are far apart, or when the number of the subject itself is doubtful.  
(Is *family* singular or plural? What about *none*? What about *neither he nor she*?)

**FAULTY:** Revision of their views about markets and averages are mandatory.

**REVISED:** Revision of their views about markets and averages is mandatory.

Sidestep the plural constructions that fall between your singular subject and its verb:

**FAULTY:** The attention of the students wander out the window.  
**REVISED:** The attention of the students wanders out the window.

**FAULTY:** The plaster, as well as the floors, need repair.  
**REVISED:** The plaster, as well as the floors, needs repair.

Collective nouns (*committee, jury, herd, group, family, kind, quartet*) are single units (plural in British usage); give them singular verbs, or plural members:

**FAULTY:** Her family were ready.  
**REVISED:** Her family was ready.

**FAULTY:** The jury have disagreed among themselves.  
**REVISED:** The jurors have disagreed among themselves.

**FAULTY:** These kind of muffins are delicious.  
**REVISED:** These muffins are delicious.  
**REVISED:** This kind of muffin is delicious.

Watch out for the indefinite pronouns—*each, neither, anyone, everyone, no one, none, everybody, nobody*. Each of these is (not *are*) singular in idea, yet each flirts with the crowd from which it singles out its idea: *each of these, either of them, none of them*. Give all of them singular verbs.

*None of these men is a failure.*  
*None of the class, even the best prepared, wants the test.*  
*Everybody, including the high-school kids, goes to Andy's Drive-In.*  
*Neither the right nor the left supports the issue.*

*None of them are* is very common. From Shakespeare's time to ours, it has persisted alongside the more precise *none of them is*, which seems to have the edge in careful prose.

When one side of the *either-or* contrast is plural, you have a

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**FAULTY:** His i  
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## ALIGNING THE

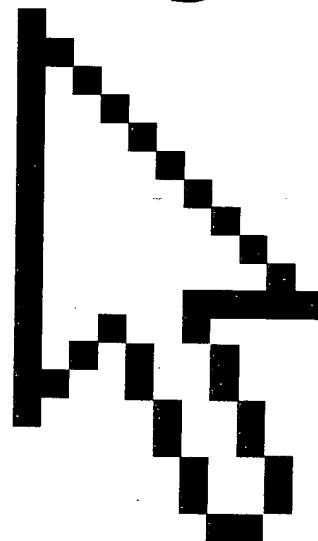
Verbs have *tense*  
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EXHIBIT B  
PAGE 2 of 3

PUBLISHED BY

Microsoft Press  
A Division of Microsoft Corporation  
One Microsoft Way  
Redmond, Washington 98052-6399

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Library of Congress Cataloging-in-Publication Data  
Microsoft Computer Dictionary.--5th ed.

p. cm.

ISBN 0-7356-1495-4

1. Computers--Dictionaries. 2. Microcomputers--Dictionaries.

AQ76.5. M52267 2002

004'.03--dc21

200219714

Printed and bound in the United States of America.

2 3 4 5 6 7 8 9 QWT 7 6 5 4 3 2

Distributed in Canada by H.B. Fenn and Company Ltd.

A CIP catalogue record for this book is available from the British Library.

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EXHIBIT B  
PAGE 3 of 3

Compressed SLIP

computer-aided design/computer-aided manufacturing

C

**Compressed SLIP** *n.* Short for Compressed Serial Line Internet Protocol. A version of SLIP using compressed Internet address information, thereby making the protocol faster than SLIP. *Acronym:* CSLIP. *See also* SLIP.

**compression** *n.* *See* data compression.

**compressor** *n.* A device that limits some aspect of a transmitted signal, such as volume, in order to increase efficiency.

**CompuServe** *n.* An online information service that is a subsidiary of America Online. CompuServe provides information and communications capabilities, including Internet access. It is primarily known for its technical support forums for commercial hardware and software products and for being one of the first large commercial online services. CompuServe also operates various private network services.

**computational intelligence** *n.* The study of the design of intelligent agents whose reasoning is based on computational methods. The central scientific goal of computational intelligence is to understand the principles that make intelligent behavior possible, in natural or artificial systems. An intelligent agent is flexible to changing environments and changing goals—it learns from experience, and it makes appropriate choices given perceptual limitations and finite computation. The central engineering goal of computational intelligence is to specify methods for the design of useful, intelligent artifacts. *See also* agents (definition 2), artificial intelligence, autonomous agent.

**computation-bound** *adj.* Of, pertaining to, or characteristic of a situation in which the performance of a computer is limited by the number of arithmetic operations the microprocessor must perform. When a system is computation-bound, the microprocessor is overloaded with calculations. *Also called:* CPU-bound.

**compute** *vb.* 1. To perform calculations. 2. To use a computer or cause it to do work.

**computer** *n.* Any device capable of processing information to produce a desired result. No matter how large or small they are, computers typically perform their work in three well-defined steps: (1) accepting input, (2) processing the input according to predefined rules (programs), and (3) producing output. There are several ways to categorize computers, including class (ranging from microcomputers to supercomputers), generation (first through fifth generation), and mode of processing (analog versus digital). See the table. *See also* analog, digital (definition

2), integrated circuit, large-scale integration, very-large-scale integration.

**Table C.1 Ways to Categorize Computers**

<i>Class</i>	Computers can be classified as supercomputers, mainframes, superminicomputers, minicomputers, workstations, microcomputers, or PDAs. All other things (for example, the age of the machine) being equal, such a categorization provides some indication of the computer's speed, size, cost, and abilities. First-generation computers of historic significance, such as UNIVAC, introduced in the early 1950s, were based on vacuum tubes. Second-generation computers, appearing in the early 1960s, were those in which transistors replaced vacuum tubes. Third-generation computers, dating from the 1960s, were those in which integrated circuits replaced transistors. Fourth-generation computers, appearing in the mid-1970s, are those, such as microcomputers, in which large-scale integration (LSI) enabled thousands of circuits to be incorporated on one chip. Fifth-generation computers are expected to combine very-large-scale integration (VLSI) with sophisticated approaches to computing, including artificial intelligence and true distributed processing.
<i>Generation</i>	Computers are either analog or digital. Analog computers, generally used in scientific pursuits, represent values by continuously variable signals that can have any of an infinite number of values within a limited range at any particular time. Digital computers, the type most people think of as computers, represent values by discrete signals—the bits representing the binary digits 0 and 1.
<i>Mode of processing</i>	<b>computer-aided design</b> <i>n.</i> <i>See</i> CAD.

**computer-aided design and drafting** *n.* *See* CADD.

**computer-aided design/computer-aided manufacturing** *n.* *See* CAD/CAM.